



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/575,193	05/23/2000	Kia Silverbrook	NPB001US	9142

24011 7590 07/22/2004

SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER

YOUNG, JOHN L

ART UNIT	PAPER NUMBER
----------	--------------

3622

DATE MAILED: 07/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/575,193

Applicant(s)

SILVERBROOK ET AL.

Examiner

John L Young

Art Unit

3622



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5,7,10-15,18,26,30-34,37,45,56 and 61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,7,10-15,18,26,30-34,37,45,56 and 61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

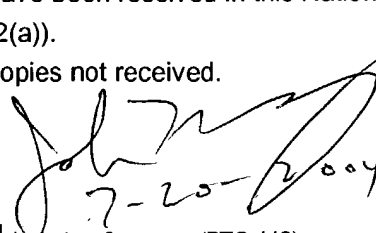
- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

JOHN LEONARD YOUNG, ESQ.
PRIMARY EXAMINER



7-20-2004

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 3622

NON FINAL REJECTION ON RCE

(Paper# 7/20/2004)

REQUEST FOR CONTINUED EXAMINATION (RCE)

1. **The request filed on 04/26/2004 for continued examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/575,193 is acceptable and an (RCE) has been established. An action on the (RCE) follows:**

STATUS

2. **Claims 3, 6, 8-9, 16-17, 19-25, 27-29, 35-36, 38-44, 46-55 & 57-60 are canceled by Applicant.**
3. **Claims 1-2, 4-5, 7, 10-15, 18, 26, 30-34, 37, 45, 56 & 61 are pending.**

CLAIM OBJECTIONS

Claims 2, 3, 4, 10, 12, 18 & 30 are objected to because of the following informalities:

4. **Claims 1-2, 4-5, 7, 10-15, 18, 26, 30-34, 37, 45, 56 & 61 are pending. The originally filed claims were claims 1-60; the present amendment attempts to insert new claim 2 and change the numbering of original claim 2 from claim 2 to claim 3 while also attempting to cancel claim 3. This is not allowed pursuant to 37 CFR 1.126. Therefore, newly added**

Art Unit: 3622

claim 2 is renumbered as claim 61. And originally filed claim 2 remains numbered as claim 2 and reads as follows:

~~2-3~~ 2. (Currently amended) A system according to claim ~~1~~ 2 1 including a plurality of printers and interface modules associated with corresponding users wherein the calculation means is responsive to the number of printed media generated that display at least one of: the first information; ~~and the~~ second information; and the third information.

The dependencies of claims 3, 4, 10 12, 18 & 30 must be changed to correspond to the renumbering of the claims pursuant to 37 CFR 1.126 and/or cancellation of the claims.

DRAWINGS

5. This application has been filed with drawings that are considered informal; said drawings are acceptable for examination purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

Art Unit: 3622

CLAIM REJECTIONS — 35 U.S.C. §103(a)

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1-2, 4-5, 7, 10-15, 18, 26, 30-34, 37, 45, 56 & 61 are rejected under 35 U.S.C. §103(a) as being unpatentable over Filion 5,778,183; class 709/223 (07/07/1998) in view of Zingher 5,897,260; class 400/719 (04/27/1999).

As per claim 1, Filion (the ABSTRACT; FIG. 5; FIG. 1; FIG. 4; FIG. 2; FIG. 6; FIG. 7; FIG. 9; FIG. 10; FIG. 11; col. 1, ll. 5-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-5; col. 4, ll. 55-67; col. 4, ll. 1-67; col. 5, ll. 5-67; col. 6, ll. 1-5; col. 6, ll. 47-67; col. 7, ll. 1-30; col. 7, ll. 35-67; col. 8, ll. 1-67; col. 9, ll. 1-67; col. 10, ll. 1-67; col. 11, ll. 1-67; col. 12, ll. 35-67; col. 13, ll. 45-67; col. 14, ll. 1-67; col. 15, ll. 1-67; and col. 16, ll. 1-27) shows: "A system for printing information from a remote source, the system including: a first data storage device that is connectable to a network and stores first information; a second data storage device that is connectable to a network and stores second information; a printer that is connectable to the network, the printer being operable to print said first and second information and at least one identifier relating to the second information: an interface module that is operatively arranged with respect to the printer to permit a user to request first information from the source such that the printer generates a first printed medium carrying the first information; and the, or each, identifier, the

Art Unit: 3622

interface module including a reader that is capable of reading the, or each, identifier to generate a request for the second information such that the printer generates a second printed medium carrying said second information. . . .”

Filion lacks explicit recitation of “a calculation means that is connectable to the network and is responsive to the module for determining a payment to be made by a second party controlling the second data storage means to a first party controlling the first data storage means.”

Zingher (FIG. 1; col. 2, ll. 5-25; col. 4, ll. 5-30; and whole document) shows “a calculation means that is connectable to the network and is responsive to the module for determining a payment to be made by a second party controlling the second data storage means to a first party controlling the first data storage means.”

Zingher provides print price calculation means that would have applied to the system of Filion. It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Zingher would have been combined with the teachings of Filion because such combination would have provided means for “*[providing] an automatic transmitting system for a printing system including a printing machine associated with a plurality of subsystems, the printing machine being operatively coupled with a print server, the print server communicating with both a first client and a second client, via a network connection. . . . for registering the information, the information including a first identifier and a second identifier . . . and corresponded with first and second sets of information. . . .*” (See Filion (col. 6, ll. 48-67)).

Art Unit: 3622

As per dependent claims 2, 4-5, 7, 10-15, 18 & 61, Filion in view of Zingher shows the system of claim 1 and subsequent base claims depending from claim 1.

Filion (the ABSTRACT; FIG. 5; FIG. 1; FIG. 4; FIG. 2; FIG. 6; FIG. 7; FIG. 9; FIG. 10; FIG. 11; col. 1, ll. 5-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-5; col. 4, ll. 55-67; col. 4, ll. 1-67; col. 5, ll. 5-67; col. 6, ll. 1-5; col. 6, ll. 47-67; col. 7, ll. 1-30; col. 7, ll. 35-67; col. 8, ll. 1-67; col. 9, ll. 1-67; col. 10, ll. 1-67; col. 11, ll. 1-67; col. 12, ll. 35-67; col. 13, ll. 45-67; col. 14, ll. 1-67; col. 15, ll. 1-67; and col. 16, ll. 1-27) in view of Zingher (FIG. 1; col. 2, ll. 5-25; col. 4, ll. 5-30; and whole document) shows the elements and limitations of dependent claims 2, 4-5, 7, 10-15, 18 & 61.

Filion lacks explicit recitation of the payment elements and limitations of dependent claims 2, 4-5, 7, 10-15, 18 & 61.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of dependent claims 2, 4-5, 7, 10-15, 18 & 61 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of dependent claims 2, 4-5, 7, 10-15, 18 & 61, because such elements and limitations would have provided *"an automatic transmitting system for a printing system including a printing machine associated with a plurality of subsystems, the printing machine being operatively coupled with a print server, the print server communicating with both a first client and a second client, via a network connection. . . . for registering*

Art Unit: 3622

the information, the information including a first identifier and a second identifier . . . and corresponded with first and second sets of information. . . .” (See Filion (col. 6, ll. 48-67)).

Independent claim 26 is rejected for substantially the same reasons as independent claim 1.

As per dependent claim 30, Filion in view of Zingher shows the system of claim 26.

Filion (the ABSTRACT; FIG. 5; FIG. 1; FIG. 4; FIG. 2; FIG. 6; FIG. 7; FIG. 9; FIG. 10; FIG. 11; col. 1, ll. 5-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-5; col. 4, ll. 55-67; col. 4, ll. 1-67; col. 5, ll. 5-67; col. 6, ll. 1-5; col. 6, ll. 47-67; col. 7, ll. 1-30; col. 7, ll. 35-67; col. 8, ll. 1-67; col. 9, ll. 1-67; col. 10, ll. 1-67; col. 11, ll. 1-67; col. 12, ll. 35-67; col. 13, ll. 45-67; col. 14, ll. 1-67; col. 15, ll. 1-67; and col. 16, ll. 1-27) in view of Zingher (FIG. 1; col. 2, ll. 5-25; col. 4, ll. 5-30; and whole document) shows the elements and limitations of dependent claim 30.

Filion lacks explicit recitation of “print the identifier with ink that does not substantially reflect light in the visible spectrum.”

Official Notice is taken that both the concepts and the advantages of the security elements and limitations of dependent claim 30 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary

Art Unit: 3622

skill in the art at the time of the invention to include the elements and limitations of dependent claim 30, because such elements and limitations would have provided *“an automatic transmitting system for a printing system including a printing machine associated with a plurality of subsystems, the printing machine being operatively coupled with a print server, the print server communicating with both a first client and a second client, via a network connection. . . . for registering the information, the information including a first identifier and a second identifier . . . and corresponded with first and second sets of information. . . .”* (See Filion (col. 6, ll. 48-67)).

Independent claim 31 is rejected for the same reasons as independent claim 1.

As per dependent claims 32-34 & 45 Filion in view of Zingher shows the method of claim 31 and subsequent base claims depending from claim 31.

Filion (the ABSTRACT; FIG. 5; FIG. 1; FIG. 4; FIG. 2; FIG. 6; FIG. 7; FIG. 9; FIG. 10; FIG. 11; col. 1, ll. 5-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-5; col. 4, ll. 55-67; col. 4, ll. 1-67; col. 5, ll. 5-67; col. 6, ll. 1-5; col. 6, ll. 47-67; col. 7, ll. 1-30; col. 7, ll. 35-67; col. 8, ll. 1-67; col. 9, ll. 1-67; col. 10, ll. 1-67; col. 11, ll. 1-67; col. 12, ll. 35-67; col. 13, ll. 45-67; col. 14, ll. 1-67; col. 15, ll. 1-67; and col. 16, ll. 1-27) in view of Zingher (FIG. 1; col. 2, ll. 5-25; col. 4, ll. 5-30; and whole document) shows the elements and limitations of dependent claims 32-34 & 45.

Filion lacks explicit recitation of the payment elements and limitations of

Art Unit: 3622

dependent claims 32-34 & 45.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of dependent claims 32-34 & 45 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of dependent claims 32-34 & 45, because such elements and limitations would have provided *“an automatic transmitting system for a printing system including a printing machine associated with a plurality of subsystems, the printing machine being operatively coupled with a print server, the print server communicating with both a first client and a second client, via a network connection. . . . for registering the information, the information including a first identifier and a second identifier . . . and corresponded with first and second sets of information. . . .”* (See Filion (col. 6, ll. 48-67)).

Independent claim 56 is rejected for the same reasons as independent claim 26.

RESPONSE TO ARGUMENTS

7. Applicant's arguments (Amendment, paper filed 04/26/2004) Applicant's arguments have been fully considered and are not persuasive for the following reasons:

Applicant's arguments are moot based on new grounds of rejection presented in the instant Office Action.

Art Unit: 3622

CONCLUSION

8. Any response to this action should be mailed to:

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

(703)305-7687 (for formal communications EXPEDITED PROCEDURE) or

(703) 305-7687 (for formal communications marked AFTER-FINAL) or

(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

Seventh Floor Receptionist
Crystal Park V
2451 Crystal Drive
Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

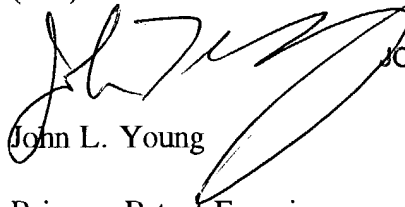
Serial Number: 09/575,193

(Silverbrook et al.)

11

Art Unit: 3622

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.



John L. Young

JOHN LEONARD YOUNG, ESQ.
PRIMARY EXAMINER

Primary Patent Examiner

July 20, 2004